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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,659	09/23/1999	HIROYUKI OGINO	35.C13851	4965

5514 7590 09/09/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/09/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

AS22

Office Action Summary

Application No.

09/401,659

Applicant(s)

OGINO ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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1. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino et al and Eguchi et al. (EP 709,222 and EP 701,904 respectively) for reasons of record and for reasons given below.

The prior art discloses a substrate having an ink-receiving layer of alumina hydrate of boehmite structure. The properties recited by the instant claims are not widely used in the art, however, the '904 patent specifically teaches the criticality of parallelization degree and '222 specifically discloses crystallite size. The references do not disclose all of the claimed properties, and the properties they disclose are not all recited in the same way as they are in the instant claims.

It is maintained that the methods of production disclosed by the prior art are the same or so similar to those of the instant specification that the articles produced should inherently have properties in accordance with the instant claims. Because of the similarity of the methods of formation and the inability of the Office to test to determine if these methods inherently yield articles meeting the instantly claimed properties, it is proper to shift the burden to applicants to demonstrate that the methods of the applied prior art will not inherently form media in accordance with the instant claims.

Applicants have argued that the claims do not literally recite all of the instant claim limitations, but have provided no evidence distinguishing the methods of the prior art. Consequently, based upon the prior art methods and the disclosures concerning properties, it would have been obvious to one of ordinary skill in the art to utilize previously disclosed methods to form a recording medium.

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2. Claims 1,4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino et al and Eguchi et al. (EP 709,222 and EP 701,904 respectively) as applied to claim 1 above, and further in view of Misuda et al. (5,104,730) or applicants' admissions on page 4 of the specification for reasons of record and for reasons given herein.

Applicant's arguments filed June 27, 2003 have been fully considered but they are not persuasive for reasons set forth above. Since the applied references are applicant's own patents, the identity of the alumina hydrate employed in the aforementioned patents is well within the applicant's purview. If in fact, the alumina hydrate employed in these patents does not possess the presently claimed difference between crystallite size and average particle thickness, applicants should clearly state so on the record. Merely arguing that the applied references don't expressly teach the parameter in question fails to answer the question of whether or not alumina hydrate having the claimed parameters was in fact employed by applicant in its earlier inventions.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 703-308-2424. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

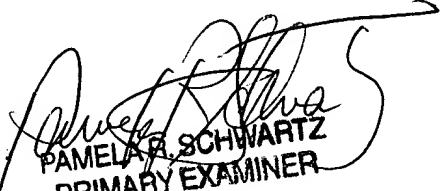
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PRSchwartz
September 7, 2003


PAMELA R. SCHWARTZ
PRIMARY EXAMINER